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Paper No. 6

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OCT 15 2002

OFFICE OF PETITIONS

In re Application of: :
Andrew C. Gilbert :
Application No. 09/995,698 :
Filed: November 29, 2001 :
Title of Invention: SYSTEMS :
AND METHODS FOR LINKING BIDS :
AND OFFERS IN A TRADING :
INTERFACE :

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b)

This is a decision on the Petition under 37 CFR 1.47(b), filed July 15, 2002, to allow the assignee to proceed with the application on behalf of and as agent for all inventors.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO RESPOND WILL RESULT IN THE ABANDONMENT OF THIS APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(b)."

The above-identified application was filed on November 29, 2001, without a fully executed oath or declaration. A Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") was mailed on December 14, 2001, noting, in relevant part, the above deficiency therein.

In response, Petitioner files the instant petition wherein Petitioner avers that the inventor is deceased and that the inventor's legal representative refuses to execute the declaration for the present application. The petition avers that a letter, along with a Declaration and Power of Attorney in connection with this application were sent to the legal representative of the deceased inventor, who failed to return the Declaration and Power of Attorney, and refused to return telephone messages left on the legal representative's answering machine.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or

declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable damage. Rule 47(b) applicant lacks items (1), (2), (5) and (6), set forth above.

As to item (1), the applicant has failed to establish that the nonsigning inventor's legal representative was ever presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

Petitioner must send a copy of the entire application, including the specification, claims and drawings, along with the oath or declaration to the nonsigning inventor before refusal can be alleged. If the application has in fact been presented to the inventor, the Petition must include this assertion in a statement of facts in support of the petition or directly in the petition. The assertion must be from a person having first hand knowledge of the presentation of the application. See MPEP 409.03(d).

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. Petitioner must include the title or position of the person signing on behalf of the company. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is REQUIRED. See MPEP 409.03(b).

As to item (5), Rule 47b applicant has failed to show or provide proof that eSpeed, Inc. (Hereinafter eSpeed), has sufficient proprietary interest in the subject matter to justify the filing of the application. Initially, it is brought to petitioner's attention that, in the absence of an assignment, the PTO will presume the named inventor to be the owner of the rights, title,

and interest to an application. See 37 CFR 3.73(a). This presumption may be overcome by proof that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

See Manual of Patent Examining Procedure ("MPEP") 409.03(f)

In the instant petitioner, Petitioner has failed to submit a copy of an assignment of the invention or a copy of an agreement to assign the invention. The MPEP further provides that

[a] proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state or foreign) would by weight of the authority in the jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of the same. The legal memorandum should be prepared and signed by an attorney-at-law familiar with the law of the jurisdiction involved. A copy (in the English language) of the statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patent Quarterly) relied on to demonstrate a proprietary interest should be made of record.

MPEP 409.03(f).

Petitioner must provide a copy of an assignment of the invention, a copy of an agreement to assign the invention¹, or a legal

¹Acceptable proof of an agreement to assign the invention would normally include a copy of an employment agreement between the inventor, and, in this instance, eSpeed, and a clear indication that the instant invention was made by the inventor during his employment with eSpeed.

memorandum signed by an attorney familiar with the law of the relevant jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to eSpeed.

As to item (6), a statement that "the filing of the application is necessary to preserve the rights of the parties", is required.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy